

**REMARKS**

Claims 1, 8, 15, and 22 stand rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As explained in more detail below, Claims 1, 8, 15, and 22 are currently amended to cure the rejection.

Claims 1, 8 and 15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Toyoda (U.S. Patent No. 6,355,966) (hereafter “Toyoda”). As will be shown below, Toyoda does not anticipate a method, system, or computer program product for administering email as claimed in the present application. Claims 1, 8 and 15 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1, 8, and 15.

Claims 2, 3, 9, 10, 16 and 17 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Toyoda in view of Cartmell et al. (U.S. Patent No. 7,039,949) (hereafter “Cartmell”). As will be shown below, neither Toyoda nor Toyoda combined with Cartmell teaches a method, system, or computer program product for administering email as claimed in the present application. Claims 2, 3, 9, 10, 16 and 17 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 2, 3, 9, 10, 16 and 17.

Claims 4-7, 11-14, and 18-24 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Toyoda in view of Shaffer et al. (U.S. Patent No. 6,092,114) (hereafter “Shaffer”). As will be shown below, neither Toyoda nor Toyoda combined with Shaffer teaches a method, system, or computer program product for administering email as claimed in the present application. Claims 4-7, 11-14, and 18-24 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 4-7, 11-14, and 18-24.

## **AMENDMENTS**

The disclosure of the present application is objected to because of the following informalities: disclosure discloses the encoding (314) but there is no label of 314 in Figures 1b and 5. The improper numbering stems from a minor clerical error in which the “Encode” element was incorrectly numbered “312” instead of “314” in Figures 1b and 5. Applicants have accordingly amended Figures 1b and 5 to correctly number the “Encode” element as “314.” In reviewing the original application, Applicants discovered a similar minor clerical error regarding the reference number for the “Encode” element on page 28 of the original application. Applicants therefore have also amended the specification at page 28, line 23 – page 29, line 1, to number the “Encode” element correctly as “314” rather than “312.” Applicants respectfully submit that these amendments add no new matter to the disclosure and cure the current objection to the disclosure.

### **Claim Rejections Under 35 U.S.C. § 112**

Claims 1-24 stand rejected under 35 U.S.C. § 112, second paragraph, “as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” The Office Action states “The following terms lack antecedent basis: the capability request – claims 1, 8, 15, and 22.” This failure of antecedent basis stems from a minor clerical error in which the original application incorrectly recited “the capability request” instead of “the email display capability request” in claims 1, 8, 15, and 22. Applicants have accordingly amended claims 1, 8, 15, and 22 to include “the email display capability request” to cure the antecedent basis failures. Applicants respectfully submit that this amendment adds no new matter to the claims and places the claims in condition for allowance.

### **Double Patenting Rejections**

Claims 1-24 are provisionally rejected on the ground of non-statutory double patenting over claims 1-21 of co-pending Application No. 10/047,018. In response, Applicants herewith submit a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321 for the present application to cure the double patenting rejections in the present application.

### **Claim Rejections – 35 U.S.C. §102**

Claims 1, 8 and 15 stand rejected under 35 U.S.C § 102(e) as being anticipated by Toyoda (U.S. Patent No. 6,335,966) (hereafter “Toyoda”). As will be shown below, Toyoda, does not anticipate dynamic indication of email capabilities as claimed in the present application. Claims 1, 8, and 15 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1, 8, and 15.

#### **Toyoda Does Not Disclose Each and Every Element Of The Claims Of The Present Application**

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As explained in more detail below, Toyoda does not disclose each and every element of claim 1, and Toyoda therefore cannot be said to anticipate the claims of the present application within the meaning of 35 U.S.C. § 102.

Currently amended independent claim 1 recites:

A method of email administration comprising the steps of:

receiving in a transcoding gateway from a sender an email display capability request for a domain, wherein the email display capability request comprises a domain identification;

finding, in dependence upon the domain identification, at least one email display capability record for the domain, wherein the email display capability record for the domain comprises display capability attributes describing an email display capability for the domain; and

sending at least one of the email display capability attributes to the sender.

**Toyoda Does Not Disclose Receiving In A  
Transcoding Gateway From A Sender An Email  
Display Capability Request For A Domain**

The Office Action takes the position that Toyoda at Figures 7 and 17; column 7, line 47 – column 8, line 14 discloses the following limitation of the first element of claim 1: receiving in a transcoding gateway from a sender an email display capability request for a domain. Applicants respectfully note in response, however, that what Toyoda at column 7, line 47 – column 8, line 14, in fact discloses is:

FIG. 7 shows one example of a sequence performed until IFAX 11A on the transmitter side obtains the capability of IFAX 11B on the receiver side from the server 14B. In other words, FIG. 7 shows the sequence of a case in which the capability information of IFAX 11B on the receiver side is not registered in the server 13A.

The IFAX 11A makes inquiry about capability information of a desired destination terminal (IFAX 11B) to the server 13A. In this example, capability information of the desired destination terminal is not registered in the server 13A. Therefore, the server 13A sends back a response in which no capability information is registered to IFAX 11A.

Next, IFAX 11A makes inquiry about capability of the destination terminal to the DNS server 14A, which manages the self-domain name, by use of a name resolver (client software for DNS). The inquiry about

capability information is carried out using a command for requesting capability information and a mail address of the destination terminal.

The structure of the domain name management in DNS will be explained with reference to FIG. 8. The DNS server 14A manages a domain name (abc: third hierarchy) in a zone A, and the DNS server 14B manages a domain name (cba: third hierarchy) in a zone B. The high DNS server 16 manages a domain name (co: second hierarchy) in a zone C including DNS servers 14A and 14B therein.

A case in which the IFAX 11A makes inquiry to the DNS server 14A, which manages the zone A by use of the domain name (cba.co.jp) of IFAX 11B will be explained. The DNS server 14A makes inquiry to the high DNS server 16, which manages the domain name (co: second hierarchy) of the zone C to which the DNS server 14A belongs since the domain name (cba) is not included in the zone A. An IP address of the high DNS server 16, which manages the domain name of the zone C, is one that is cached at an initial obtaining time.

That is, Toyoda at this point discloses making an inquiry about capability information to a server 13A (column 7, lines 53-55) and making an inquiry about capability information to a DNS server 14A (column 7, lines 59-62) but does not teach or disclose a transcoding gateway as claimed in the present application. Toyoda's "makes inquiry about capability information of a desired destination terminal" does not disclose receiving in a *transcoding gateway* from a sender an email display capability request for a domain as claimed in the present application. As described in the present application, a transcoding gateway is, "is a server capable of transcoding messages from one format to another, as for example, from email objects to files stored in file systems or from digital object in emails to transcoded digital object suitable for display upon display devices, including for example, video screen, audio players, digital art frames, television sets controlled by set top boxes, text to speech converters in automobiles, and so on." (Applicant's Original Specification, page 12, lines 6-11) Toyoda's server 13A is described at column 6, lines 34-42 as follows:

The server 13A has a function of notifying the capability exchange section 31 of capability information about the destination terminal in response to inquiry from the capability exchange section 31. The server 13A stores capability information about the destination terminals in a capability

exchange table 50. Also, the server 13A registers capability information whose registration is requested from the capability registration section 37 into a capability exchange table 50.

That is, Toyoda's server 13A is concerned with exchanging capability information but has no functionality of transcoding as claimed in the present invention. The DNS server disclosed in Toyoda is described at column 4, lines 51-56 as follows:

The DNS server 14A is a name server, which manages a domain name of IFAX 11A, and capability information of the network terminals existing in a zone (first LAN 10A in this embodiment) is registered therein.

That is, Toyoda's DNS server 14A is a name server as is known in the art and cannot be said to be a transcoding gateway as claimed in the present application because Toyoda's DNS server does not transcode messages from one format to another. Toyoda does not at any point disclose or even suggest a transcoding gateway as claimed in the present application. Furthermore, Toyoda is concerned with obtaining the capability information of a single destination terminal and at no point discloses receiving in a transcoding gateway from a sender an email display capability request for a *domain*. The domain as claimed in the current application "...refers to a group of client devices administered together and identified by a common network address, typically an internet protocol address, that resolves to a domain name." (Page 30, line 6-8 of Applicant's Original Specification). "The desired destination terminal" taught in Toyoda cannot possibly be said to be a domain as claimed in the present invention. Because Toyoda does not disclose receiving in a transcoding gateway from a sender an email display capability request for a domain as claimed in the present application Toyoda does not disclose each and every element and limitation of applicants' claims. Toyoda therefore cannot possibly be said to anticipate Applicants' claims and the rejections should be withdrawn.

**Toyoda Does Not Disclose Finding, In Dependence  
Upon The Domain Identification, At Least One  
Email Display Capability Record For The Domain**

The Office Action takes the position that Toyoda at Figures 7 and 17 and column 8, lines 47-55 discloses the following limitation of the second element of claim 1: finding, in dependence upon the domain identification, at least one email display capability record for the domain. Applicants respectfully note in response, however, that what Toyoda at column 8, lines 47-55 in fact discloses is:

As mentioned above, capability information of the destination terminal (IFAX 11B) is registered in the DNS server 14B, which manages the domain name of the desired destination terminal (IFAX 11B). Therefore, the DNS server 14B gives a response of capability information of the desired destination terminal to the DNS server 14A. The DNS server 14A transmits the obtained capability information of the destination terminal to the IFAX 11A.

The “gives a response of capability information of the desired destination terminal” of Toyoda does not disclose finding, in dependence upon the domain identification, at least one email display capability record for the domain as claimed in the present application. The step of finding as claimed in the present application takes place within the transcoding gateway (Applicant’s Original Disclosure page 30, lines 19-23 and Figure 11). As explained above, Toyoda does not teach a transcoding gateway and therefore cannot possibly be said to teach the step of finding as claimed in the present invention. Furthermore, as mentioned above, Toyoda’s “desired destination terminal” cannot be said to be a domain as claimed in the present application, and Toyoda therefore cannot be said to disclose finding, in dependence upon the domain identification, at least one email display capability record for the domain. Because Toyoda does not disclose each and every element and limitation of applicants’ claims, Toyoda does not anticipate Applicants’ claims, and the rejections should be withdrawn.

**Toyoda Does Not Disclose Wherein The Email Display  
Capability Record For The Domain Comprises Display Capability  
Attributes Describing An Email Display Capability For The Domain**

The Office Action takes the position that Toyoda at Figures 5 and column 6, lines 43-65 discloses the following limitation of the second element of claim 1: wherein the email

display capability record for the domain comprises display capability attributes describing an email display capability for the domain. Applicants respectfully note in response, however, that what Toyoda at column 6, lines 43-65 in fact discloses is:

FIG. 5 shows a configuration example of the capability exchange table 50. In the capability exchange table 50, one or a plurality of names of the kind of destination terminal is registered to be associated with the mail address of the destination terminal. Capability of the destination terminal is determined in accordance with the kind of destination terminal. In the capability exchange table 50, a capability table is prepared for each kind of destination terminal. In the capability table, there are described capability items such as resolution, a paper size, a compression format, an encryption format, color, and the other, and a capability content corresponding to each capability item.

In this way, by managing the capability of the destination terminal by the name of kind of apparatus, a data capacity of the capability exchange table 50 can be reduced as compared with a case in which capability information is registered for each destination terminal. The destination terminal of the same kind of terminal is regarded as the terminal that has substantially the same capability. Therefore, if the capability of the destination terminal is managed by the name of the kind of apparatus, overlaps of data can be avoided, and data can be managed with efficiency.

The “resolution, a paper size, a compression format, an encryption format, color” and so on of Toyoda does not disclose wherein the email display capability record for the domain comprises display capability attributes describing an email display capability for the domain as claimed in the present application. Toyoda discloses capability information of a single destination terminal and not a domain as claimed in the present application. It cannot be said then, that Toyoda teaches an email display capability record for the *domain* comprising display capability attributes describing an email display capability for the *domain* as claimed in the present application. Because Toyoda does not disclose each and every element and limitation of applicants’ claims, Toyoda does not anticipate Applicants’ claims, and the rejections should be withdrawn.

**Toyoda Does Not Disclose Sending At Least One Of  
The Email Display Capability Attributes To The Sender**



The Office Action takes the position that Toyoda at Figures 7 and 17, column 8, lines 24-33 and column 8, lines 53-57 discloses the third element of claim 1: sending at least one of the email display capability attributes to the sender. Applicants respectfully note in response, however, that what Toyoda at column 8, lines 24-33, in fact discloses is:

The DNS server 14A, which has received inquiry from the IFAX 11A, sends back a response of corresponding capability information to the IFAX 11A when the inquiry can be solved by a zone information table 60A, which the DNS server 14A itself has. In this example, capability information of the destination terminal is not registered in the DNS server 14A. In an unsolvable case, that is, a case of inquiry about a domain name of a zone other than the self-zone, inquiry is made to the high DNS server 16. This inquiry is referred to as recursion.

And Toyoda at column 8 lines, lines 53-57 discloses:

The DNS server 14A transmits the obtained capability information of the destination terminal to the IFAX 11A.

Also, in DNS, even if the low DNS server(14A), which has received inquiry from the client, makes inquiry to a route server, which manages a top domain directly, it is possible to search for an IP address of a DNS server, which manages a desired domain name.

The “transmits the obtained capability information of the destination terminal” of Toyoda does not disclose sending at least one of the *email display capability attributes* to the sender as claimed in the present application. Toyoda does not teach email display capability attributes describing an email display capability for the domain. Toyoda then cannot be said to teach sending at least one of the email display capability attributes to the sender. Because Toyoda does not disclose each and every element and limitation of applicants’ claims, Toyoda does not anticipate Applicants’ claims, and the rejections should be withdrawn.

### **Relations Among Claims**

Independent claims 8 and 15 are system and computer program product claims for email administration corresponding to independent method claim 1 that include “means for” and “means, recorded on [a] recording medium, for” email administration. As discussed above, Toyoda discloses a method for making inquiry about capability of a destination terminal. (Toyoda’s abstract) For the same reason that Toyoda does not disclose a method of email administration, Toyoda also does not disclose systems and computer program products for email administration corresponding to independent claims 8 and 15. Independent claims 8 and 15 are therefore patentable and should be allowed.

### **Claims 2, 3, 9, 10, 16 and 17 Stand Rejected Under 35 U.S.C. § 103**

Claims 2, 3, 9, 10, 16 and 17 stand rejected under 35 U.S.C § 103(a) as unpatentable over Toyoda in view of Cartmell *et al.* (U.S. Patent No. 7,039,949) (hereafter “Cartmell”). To establish a prima facie case of obviousness under 35 U.S.C. § 103 the proposed combination of the references must teach or suggest all of Applicants’ claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). As explained below, the combination of Toyoda and Cartmell does not establish a prima facie case of obviousness for claims. Applicants respectfully traverse the rejections of claims 2, 3, 9, 10, 16 and 17.

### **The Combination Of Toyoda and Cartmell Does Not Teach All Of Applicants’ Claim Limitations Of Dependent Claims 2, 3, 9, 10, 16 and 17**

In rejecting dependent claims 2, 3, 9, 10, 16 and 17, the Office Action relies on the previous §102 rejection arguing that Toyoda discloses each and every limitation of claims 1, 8, and 15. As explained above, however, Toyoda does not disclose each and every element of independent claims 1, 8, and 15. To establish a prima facie case of obviousness, the proposed combinations of the references must teach or suggest all of the

claim limitations of dependent claims 2, 3, 9, 10, 16 and 17. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Dependent claims 2 and 3 include all limitations of independent claim 1. Dependent claims 9 and 10 include all limitations of independent claim 8. Dependent claims 16 and 17 include all limitations of independent claim 15. Because the proposed combination of Toyoda and Cartmell relies on the argument that Toyoda teaches each and every element of independent claims 1, 8, and 15, and because Toyoda in fact does not teach or suggest each and every element of independent claim 1, 8, and 15, the proposed combinations cannot teach or suggest all the claim limitations of dependent claims 2, 3, 9, 10, 16 and 17. The proposed combination of Toyoda and Cartmell therefore cannot establish a prima facie case of obviousness, and the rejections should therefore be withdrawn.

### **Claims 4-7, 11-14, and 18-24 Stand Rejected Under 35 U.S.C. § 103**

Claims 4-7, 11-14, and 18-24 stand rejected under 35 U.S.C § 103(a) as unpatentable over Toyoda in view of Shaffer *et al.* (U.S. Patent No. 6,092,114) (hereafter “Shaffer”). To establish a prima facie case of obviousness under 35 U.S.C. § 103 the proposed combination of the references must teach or suggest all of Applicants’ claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). As explained below, the combination of Toyoda and Shaffer does not establish a prima facie case of obviousness for claims. Applicants respectfully traverse the rejections of claims 4-7, 11-14, and 18-24.

### **The Combination Of Toyoda and Shaffer Does Not Teach All Of Applicants’ Claim Limitations Of Claims 4-7, 11-14, and 18-24**

In rejecting claims 4-7, 11-14, and 18-24, the Office Action relies on the previous §102 rejection arguing that Toyoda discloses each and every limitation of claims 1, 8, and 15. As explained above, however, Toyoda does not disclose each and every element of independent claims 1, 8, and 15. To establish a prima facie case of obviousness, the proposed combinations of the references must teach or suggest all of the claim limitations

of claims 4-7, 11-14, and 18-24. In re Royka, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Dependent claims 4-7 include all limitations of independent claim 1. Dependent claims 11-14 include all limitations of independent claim 8. Dependent claims 18-21 include all limitations of independent claim 15. Independent Claim 22 includes all limitations of independent claim 1. Dependent claims 23-24 depend from claim 22 and therefore include all limitations of independent claim 1. Because the proposed combination of Toyoda and Shaffer relies on the argument that Toyoda teaches each and every element independent claims 1, 8, and 15, and because Toyoda in fact does not teach or suggest each and every element of independent claim 1, 8, and 15, the proposed combinations cannot teach or suggest all the claim limitations of claims 4-7, 11-14, and 18-24.. The proposed combination of Toyoda and Shaffer therefore cannot establish a prima facie case of obviousness, and the rejections should therefore be withdrawn.

### **Relations Among Claims**

Independent claims 8 and 15 are system and computer program product claims of the method of claim 1. Claim 22 includes all limitations of claim 1. Claims 8, 15, and 22 therefore are patentable for the same reasons that claim 1 is patentable as described above. Dependent claims 2-7, 9-14, 16-21, and 22-24 include each and every limitation of the independent claims from which they depend. The dependent claims stand because their respective independent claims stand.

### **Conclusion**

Claims 1-24 are provisionally rejected on the ground of non-statutory double patenting over claims 1-21 of co-pending Application No. 10/047,018. Applicants respectfully propose that the accompanying Terminal Disclaimer cures the rejections of claims 1-24 in the present application on the grounds of non-statutory double patenting.

Claims 1, 8 and 15 stand under 35 U.S.C § 102 as being anticipated by Toyoda. Toyoda does not disclose each and every element of Applicants' claims. Toyoda therefore does not anticipate Applicants' claims. Claims 1, 8, and 15 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 1, 8 and 15.

Claims 2, 3, 9, 10, 16 and 17 stand rejected under 35 U.S.C § 103 as obvious over Toyoda in view of Cartmell. The combination of Toyoda and Cartmell does not teach or suggest each and every element of Applicants' claims. Claims 2, 3, 9, 10, 16 and 17 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 2, 3, 9, 10, 16 and 17.

Claims 4-7, 11-15, and 18-24 stand rejected under 35 U.S.C § 103 as obvious over Toyoda in view of Shaffer. The combination of Toyoda and Shaffer does not teach or suggest each and every element of Applicants' claims. Claims 4-7, 11-15, and 18-24 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 4-7, 11-15, and 18-24.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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